

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
	:	
Virinder BATRA, et al.	:	Confirmation Number: 3519
	:	
Application No.: 10/077,012	:	Group Art Unit: 2145
	:	
Filed: February 15, 2002	:	Examiner: A. Choudhury
	:	
For: COMMON LOCATION-BASED SERVICE ADAPTER INTERFACE FOR LOCATION BASED SERVICES		

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated August 23, 2010 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Third Appeal Brief of March 12, 2008 (hereinafter the Third Appeal Brief), and in the Reply Brief of August 8, 2008. Appellants will specifically identify these particular points below.

REMARKS

Standard of Review

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus, the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

On February 26, 2010, the precedential opinion of Ex parte Frye, Appeal 2009-006013, was issued by the Board of Patent Appeals and Interferences (BPAI). Referring to the first full paragraph on page 15 of Ex parte Frye, the following was stated:

Our decision is limited to the finding before us for review. The Board does not "allow" claims of an application and cannot direct an examiner to pass an application to issuance. Rather, the Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner. See 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner").[footnote 2 omitted] (underline added)

The Honorable Board further went on to state within Ex parte Frye that:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 (“In reviewing the examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.”) (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief must include “the contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on”). Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.

As discussed above, a decision of the BPAI is limited to the findings and conclusions made by the Examiner. Additionally, a complete *de novo* review is to be performed on all issues that are raised by Appellants without deference to the positions taken by the Examiner. However, the Honorable Board did not limit its Decision to case law presented by the Examiner and the findings and conclusions made by the Examiner. Instead, the Honorable Board relied upon findings and conclusions not made by the Examiner and were presented by the Honorable Board for the first time within the Decision. Therefore, Appellants respectfully submit that the Honorable Board has not followed the precedential option of Ex Parte Frye by not limiting the Decision to findings and conclusion made by the Examiner.

New ground of rejection

If the Honorable Board believes that the present rejection should be maintained, designation as a new ground is necessary because Appellants have not had a fair opportunity to

react to the thrust of the "affirmance" of the rejection, which is based upon a characterization of the prior art that was not relied on by the Examiner. See In re Kumar, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976)). Denial of an opportunity to respond to a new rejection represents a deprivation of the Appellants' administrative due process rights. In re Kronig 539 F.2d at 1303, 190 USPQ at 426. A further discussion of what constitutes a new grounds of rejection is found below.

New Findings of Fact

In the statement of the rejection within both the appealed Sixth Office Action and in the Examiner's Answer, the Examiner cited to Fig. 9 and paragraphs [0107], [0209], [0213], and [0215] of Requena. In the "Response to Arguments" section of the Examiner, the Examiner also cited paragraphs [0107], [0209], [0213], and [0215] of Requena. These cited portions from Requena represent the findings made by the Examiner during prosecution. Referring to pages 5 and 6 of the Decision, the Honorable Board identified "Findings of Fact" upon which the Decision was based.

Referring to finding of fact (2), the Honorable Board cited paragraphs [0043]-[0045], [0061]-[0063], [0075], [0210], [0212], and Figs. 1-4 of Requena. Notably, none of these passages or figures were cited by the Examiner in either the appealed Sixth Office Action or the

Examiner's Answer. Thus, the Honorable Board's reliance upon these new findings constitutes a new grounds of rejection.

Referring to finding of fact (3), the Honorable Board cited paragraphs [0082]-[0086] of Requena. Again, none of these passages were cited by the Examiner in either the appealed Sixth Office Action or the Examiner's Answer. Thus, the Honorable Board's reliance upon these new findings constitutes a new grounds of rejection.

Referring to finding of fact (4), the Honorable Board cited paragraphs [0118]-[0120] of Requena. Although paragraph [0120] was cited by the Examiner in the context of dependent claim 2, none of these passages were cited by the Examiner in either the appealed Sixth Office Action or the Examiner's Answer with regard to independent claim 1, which is the claim at issue. Thus, the Honorable Board's reliance upon these new findings constitutes a new grounds of rejection.

Referring to finding of fact (5), the Honorable Board cited paragraphs [0187]-[0188], [0204]-[0215], and Fig. 9 of Requena. Although the Examiner cited to the Figure and three of these fifteen passages, the remaining twelve passages were not cited by the Examiner in either the appealed Sixth Office Action or the Examiner's Answer. Thus, the Honorable Board's reliance upon these new findings constitutes a new grounds of rejection.

Findings of fact (1) and (6) respectively referred to Appellants' Specification and the secondary reference of Lee. Thus, the vast majority of the findings, relied upon by the

Honorable Board, with regard to the primary reference of Requena were not cited by the Examiner in either the appealed Sixth Office Action and in the Examiner's Answer. In so doing, the Honorable Board has presented several new grounds of rejection.

Referring to the first line of the last full paragraph on page 8 of the Decision, the Honorable Board asserted "we find that Lee is cumulative in this regard." As such, the Honorable Board has, in essence, converted the rejection of claim 1 under 35 U.S.C. § 103 based upon Requena and Lee into a rejection under 35 U.S.C. § 102. For reasons subsequently discussed in this Request for Rehearing under the heading "New Grounds of Rejection," such a change in analysis constitutes a new grounds of rejection.

Applicants also note that a rejection of claim 1 under 35 U.S.C. § 102 based upon Requena was appealed in the First Appeal Brief dated January 17, 2007 (hereinafter the First Appeal Brief). Notably, the claim 1 that was subject to the First Appeal Brief is identical to claim 1, which is the subject of the present appeal. Moreover, in response to the First Appeal Brief, the Examiner withdrew the rejection of claim 1 under 35 U.S.C. § 102 based upon Requena. Thus, not only does Appellants disagree that a rejection of claim 1 under 35 U.S.C. § 102, the Examiner has also been persuaded that a rejection of claim 1 under 35 U.S.C. § 102 is not proper.

Referring to the paragraph spanning pages 7 and 8 of the Decision, the Honorable Board initially asserted the following:

Additionally, Requena states a message's content has a specific format, such as SDP, text, or XML. FF 3. Thus, Requena teaches specifically formatting each request according to a specific format and suggests that message's originator (e.g., a location-based service provider that provides a service message (*see* FF 5)) specifies this format and is capable of specifying a different specific format.

At the outset, Appellants note that this is a line of arguments that was not presented by the Examiner. On the contrary, referring to the first two lines on page 9 of the Examiner's Answer, the Examiner asserted "Requena does not explicitly teach a uniform format for the results produced from corresponding requests." This line of arguments and accompanying findings of fact represents a new grounds of rejections.

Referring again to the paragraph spanning pages 7 and 8 of the Decision, the Honorable Board initially asserted the following:

While we agree with Appellants that the preamble of claim 1 is entitled to patentable weight (Reply Br. 5-6), we also find that phrase, "a plurality of disparate location-based service providers, different ones of said plurality of disparate location-based service providers specifying different formats for receiving requests," in preamble of claim 1 is an intended use limitation. Such language covers any structure capable of performing the recited function. See *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971). As stated above, Requena teaches and suggests location-based service providers capable of specifying different formats. Moreover, we note that the body of claim 1 recites "a particular location-based service provider" rather than referring back to the different location-based service providers in claim preamble. The location-based service provider recited

1 in the body of claim 1 does not therefore have to be one of the providers
2 specifying different formats recited in the preamble. (emphasis added)

3
4 Appellants respectfully submits that this analysis overlooks the claimed invention and
5 what Requena would have suggested to one skilled in the art. The claimed invention involves
6 uniformly formatting each result set that is produced from the plurality of disparate location-
7 based service providers. However, each of these location-based providers specify different
8 formats for receiving requests. As such, each request has to be specifically formatted according
9 to the specific format specified by the particular location-based provider to which the request is
10 to be sent.

11
12 Notably, paragraph [0119] of Requena teaches:

13 There is a coding mechanism selected/designed for coding/decoding all
14 the messages. All the users must support the coding mechanism. (emphasis
15 added)

16
17 The Honorable Board's refers to what Requena teaches what the location-based service providers
18 are capable of specifying. However, obviousness is not based upon capabilities, as stated by the
19 Federal Circuit, "[i]n determining whether obviousness is established by combining the teachings
20 of the prior art, the test is what the combined teachings of the references would have suggested to
21 those of ordinary skill in the art." In re GPAC Inc., 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal
22 quotations omitted).

23
24 As argued in lines 5-6 of the Third Appeal Brief, Requena teaches the use of a single
25 preferred format (see paragraph [0119] of Requena, which is reproduced above). Although

1 Requena contemplates that different formats (i.e. coding mechanisms) can be used, Requena
2 teaches that only a single coding mechanism (see, e.g., paragraph [0120], which states "users
3 support the basic coding mechanism selected as default for all the transactions") is used for all
4 the transactions.

5
6 The logic behind these teachings of Requena's is straightforward. By having a single
7 coding mechanism, there is no need to keep track of different formats. Also, there is no need to
8 have a system in place to (i) recognize the proper format and (ii) convert a request from one
9 format to another format. Also, there is also no need to uniformly format an incoming result set
10 since each incoming result set has already be formatted using the default coding mechanism.

11
12 This system of Requena, however, is a rigid system. For example, if a location-based
13 provider is incapable of supporting the particular coding mechanism that was selected, then this
14 location-based provider cannot be used within the system of Requena. The claimed invention,
15 however, permits location-based service providers that specify different formats to be used. The
16 claimed invention provides this flexibility by specifically formatting each request according to
17 the format specified by the particular location-based service provider. Flexibility is also
18 provided by uniformly formatting the result sets from the location-based service providers. In so
19 doing, no matter the format of the result set outputted by a particular location-based service
20 provider, the requester (i.e., the location based service application) can expect uniformly
21 formatted result set.

1 Finally, Appellants note that the "intended use" argument was first presented by the
2 Examiner in the Examiner's Answer. This argument was addressed on page 5, line 10 through
3 page 6, line 20 of the Reply Brief. Notably, Appellants argued that the "intended use" argument
4 does not apply to claim 3 since the limitations at issue are found in the body of claim 3. The
5 Honorable Board, however, has not addressed this issue. Also, the Honorable Board's analysis
6 has not addressed any of the specific arguments presented on page 6, lines 9-20 of the Reply
7 Brief.

8
9
10 Referring again to the first full paragraph on page 8 of the Decision, the Honorable Board
11 asserted the following:

12 As Appellants indicate (App. Br. 10), Requena also states all messages are
13 also coded and decoded using a coding mechanism, such as a text-based language
14 (e.g., XML or GML) (FF 4)—a teaching that at least suggests uniform formatting.
15 However, claim 1 includes the open-ended transitional phrase, "comprising," that
16 does not exclude additional, unrecited steps. See Mars Inc. v. H.J. Heinz Co., 377
17 F.3d 1369, 1376 (Fed. Cir. 2004). Requena can thus both specifically and
18 uniformly format messages and still meet the limitations of claim 1. Moreover,
19 since messages include responses (FF 2) (i.e., result sets), we find that Requena
20 also teaches "uniformly formatting each result set produced from" the requests as
21 recited in claim 1.

22
23 Appellants respectfully but vigorously disagree with the Honorable Board's new reasoning.
24 Moreover, since it is a new reasoning that was not presented in either the appealed Sixth Office
25 Action or the Examiner's Answer, this new reasoning constitutes a new grounds of rejection.

1 The case law cited by the Honorable Board stands for the proposition that the claimed
2 invention, via use of the term "comprising," does not exclude additional, unrecited steps, and
3 Appellants do not take issue with this case law, as it is stated. However, Appellants disagree
4 with the Honorable Board's assertion that "Requena can thus both specifically and uniformly
5 format messages and still meet the limitations of claim 1."

6
7 At the outset, Appellants note that Honorable Board does not correctly state the
8 limitations at issue. Specifically, the Honorable Board refers to "messages" that are "specifically
9 and uniformly format[ed]." The claimed invention, however, does not refer to messages that are
10 both specifically and uniformly formatted. Instead, the claimed invention recites "specifically
11 formatting each said request according to a specific format specified by said particular location-
12 based service provider" and "uniformly formatting each result set." Thus, the requests are
13 specifically formatted and the result sets are uniformly formatted. As already discussed above,
14 Requena requires that all users employ the same coding mechanism, and thus there is no need to
15 perform an operation of specifically formatting a request to a location based service provider nor
16 a need to uniformly format an incoming result set from the location based service provider. For
17 example, the incoming result set is already uniformly formatted, and thus, there is no need to
18 perform this additional operation.

19
20
21 Referring to the last full paragraph on page 8 of the Decision, the Honorable Board
22 asserted the following:

23 Although we find that Lee is cumulative in this regard, we nevertheless
24 are not persuaded of error in the Examiner's position (Ans. 9) that, in light of Lee,

1 it would have been obvious to use XML to uniformly format messages generally,
2 including responses to requests. Although cumulative, Lee nonetheless bolsters
3 the notion that Requena's use of XML to uniformly format messages would have
4 been obvious.

5
6 As noted above, the Honorable Board is to perform a complete *de novo* review on all issues that
7 are raised by Appellants without deference to the positions taken by the Examiner.

8
9 The Honorable Board, however, does not address any of the points raised by Appellants
10 on page 9, line 5 through page 10, line 21 of the Third Appeal Brief. Appellants do note,
11 however, that the Honorable Board is correct in asserting that "Lee is cumulative" to the
12 teachings found within Requena (see arguments presented by Appellants on page 10, lines 5-11
13 of the Third Appeal Brief). However, these teachings do not correspond to the claimed
14 limitations.

15
16
New Grounds of Rejection

17
18 The Honorable Board's new findings and new analysis constitute new grounds of
19 rejection. Although a new rejection is commonly thought as being a "new grounds of rejection,"
20 a new rejection is not the only situation in which a designation of new grounds of rejection is
21 appropriate.¹

22

¹ *Hyatt v. Dudas*, 551 F.3d 1307, 1312–13, 89 USPQ2d 1465, 1468–69 (Fed. Cir. 2008) (in the context of "written description," rejecting the PTO's contention that "ground of rejection" is limited to "merely the statutory section").

1 Within In re Kumar,² an example of a "new grounds of rejection" was identified by the
2 Federal Circuit. The patent application at issue within In re Kumar is U.S. Application No.
3 09/136,483. On February 29, 2000, a Final Office Action was issued in which claims 1-3, 5-16,
4 and 19-22 were rejected under 35 U.S.C. § 103 based upon Rostoker et al., U.S. Patent No.
5 5,389,194 alone or in view of Ueda et al., U.S. Patent No. 5,697,992. On February 27, 2003, the
6 Board of Patent Appeals & Interferences (hereinafter the BPAI) affirmed the Examiner's
7 rejection based upon findings of fact (i.e., calculations) that were not presented by the Examiner.
8 With regard to these new findings of fact, the Federal Circuit determined:

9 These calculations had not been made by the examiner, and according to
10 the record were not presented during the argument of the appeal to the Board. The
11 Board apparently made these calculations during its decision of the appeal. The
12 Board included these calculations in an Appendix to its decision, holding that they
13 support a *prima facie* case of obviousness and that Kumar's evidence had not
14 rebutted the *prima facie* case.

15
16 In addressing rebuttal evidence that was presented (and refused consideration) in
17 response to the BPAI's findings, the Federal Circuit further stated:

18 The values identified by the Board's calculations were not contained in the
19 prior art or any examination record, but appeared for the first time in the Board's
20 opinion. Although the PTO argues that the calculations the Board included in its
21 decision were not new evidence, but simply an additional explanation of the
22 Board's decision, these values produced and relied on by the Board had not
23 previously been identified by the examiner or the Board. Kumar was entitled to
24 respond to these calculations, and the Board committed procedural error in
25 refusing to consider the evidence proffered in response.
26

² 418 F.3d 1361, 1365. (Fed. Cir. 2005).

1 The Federal Circuit concluded that "the Board's calculations and its decision based
2 thereon constituted a new ground of rejection." Thus, the introduction of new findings, even
3 though these findings related to a previously-presented rejection, constituted a new grounds of
4 rejection.

5
6 Referring In re DeBlauwe, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984), the Federal Circuit
7 further stated "[w]here the board makes a decision advancing a position or rationale new to the
8 proceedings, an applicant must be afforded an opportunity to respond to that position or rationale
9 by submission of contradicting evidence"). Referring to In re Ahlert, 424 F.2d 1088, 1098, 165
10 USPQ 418, 421 (CCPA 1970), the Court stated "combining the disclosures of the references with
11 the new facts judicially noticed, amounted to a new ground of rejection." Within In re Eynde,
12 480 F.2d 1364, 1371, 178 USPQ 470, 475 (CCPA 1973), the Court stated that even though
13 Board's new rationale was in response to arguments made in the Reply Brief, it was nonetheless
14 deemed a "new ground."

15
16 In response to the BPAI denying a request that the BPAI designate a rejection as "new"
17 and allow new evidence to be introduced, within In re Ansel, 852, F.2d 1294 (Fed. Cir. 1988)
18 (designated as an Unpublished Disposition), the Federal Circuit stated:

19 We cannot agree with the board that its reasoning does not represent a significant
20 shift in the basic thrust of the rejection. Not only do the rejections at issue here
21 represent different views of what the cited references teach, they also require the
22 applicants to respond in quite different manners.

In a situation very like the facts of present Application, the Court of Customs and Patent Appeals (i.e., the predecessor to the Federal Circuit), stated the following within In re Echerd, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973):

We find the new reliance by the board on Gouveia alone to be in effect a new ground of rejection. New portions of the reference are relied upon to support an entirely new theory and the statutory basis for rejection appears to have been shifted to 35 U.S.C. § 102. Under such circumstances, appellants should have been accorded an opportunity to present rebuttal evidence.

Appellants are aware that In re Bush, 296 F. 2d 491, 496, 131 USPQ 263, 266-267 (CCPA 1961), has been cited for the proposition that "[t]he Board may rely on less than all of the references applied by the Examiner in an obviousness analysis without designating it as a new ground of rejection." This assertion, however, is limited by the specific set of facts attendant to the decision of In re Bush, and those set of facts to no apply to the present application.

Specifically, the CCPA made the finding that in "[i]n the final rejection, the examiner said 'Claims 28 and 29 are *finally* rejected as unpatentable over either Harth or Whitney, both of record, either one alone, or both considered together'" (emphasis in original). The CCPA also found that "Appellant admits the final rejection included a rejection on Whitney alone." In addressing the issue of whether a "new rejection" was proper, the CCPA concluded:

In restating the grounds on which the claims *had been* rejected, the examiner's answer failed to mention one of those ways but did not withdraw it. In applying Rule 196(a), it seems to us that the words "grounds * * * specified by the examiner" must be construed to include all grounds relied on at final rejection and not clearly withdrawn by the examiner's answer, notwithstanding what appears to

be an office practice (which may find support in M.P.E.P. 1208) to regard grounds of rejection not repeated in the answer as withdrawn by implication. (emphasis in original)

Thus, In re Black stands for the proposition that where the Examiner indicates, in the Office Action from which the appeal is taken, that a rejection can be based upon a single reference alone or in combination with another reference, it does not constitute a new grounds of rejection when the BPAI relies upon the single reference. The justification for this is that the rejection of the claim based upon the single reference was already grounds from which the appeal was taken. Therefore, this does not constitute a new grounds of rejection.

The fact pattern described by the CCPA within In re Black does not apply to the present situation. The Sixth Office Action, from which the appeal was taken, did not indicate a rejection of claim 1 based upon Requena alone. In fact, as already noted above, the Examiner had already been convinced, as a result of the First Appeal Brief, that a rejection based upon Requena alone does not apply. Since the facts described within In re Black do not apply to the present application, In re Echerd is controlling law, and requires that a new grounds of rejection be indicated.

Based upon the above-discussed decisions, Appellants' position is that the Honorable Board's new analysis and new findings constitute new grounds of rejection. Since it is impossible for Appellants to have responded to this new analysis, Appellants were not afforded a fair opportunity to react to the new thrust of the rejection. Therefore, should the Honorable Board maintain the present rejections of the claims based upon Requena and Lee, Appellants

Application No.: 10/077,012

- 1 respectfully request that the Honorable Board enter a new ground of rejection pursuant to 37
- 2 C.F.R. § 41.50(b).

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: October 25, 2010

Respectfully submitted,

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CUSTOMER NUMBER 46320